

REMARKS

Claims 1, 3-5, 7-11, 13-15 and 17-21 are pending in this application. Claims 1 and 11 are independent claims. By this Amendment, claims 1, 8, 11, 15 and 18 are amended and new claim 21 is added. No new matter is added.

Claim Rejections under 35 U.S.C. §103

Claims 1 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 3,638,157 to Kruzic in view of US Patent 4,054,818 to Risberg. The rejection is respectfully traversed.

Kruzic relates to a circuit-interrupting device for opening the circuit to a motor and a motor overload responsive device for initiating opening of the motor circuit with a time delay upon the flow of an overload current in the range between a current above the full-load current to the motor and the locked rotor current of the motor. The device includes a combination motor starter 5 having an enclosure 7, a circuit interrupter 8 that comprises a multipole circuit breaker 9 and a multipole fuse unit 11, a multipole contactor 13, and a multipole overload relay 15 (Figs. 1 and 2).

It is alleged in the Office Action that the circuit breaker 9 and fuse 11 correspond to the claimed “first protective element” and “second protective element,” respectively. It is also alleged that the arrangement of the two protective elements “is immaterial and is nothing but a case of rearrangement of parts.” Applicant respectfully disagrees. The claimed arrangement of the second protective element relative to the first protective element is material at least because the second protective element provides short-circuit protection of the first protective element and the motor.

Further, the Examiner relies on *In re Kuhle* in support of the rejection. In *In re Kuhle*, the court stated that the particular placement of a contact was held to be an obvious matter of design choice. However, as further stated in MPEP §2144.04, the mere fact that a worker could rearrange parts of a reference device to meet the terms of a claim is not by itself sufficient to support a finding of obviousness. Rather, the prior art must provide motivation or reason for the worker in the art, without the benefit of the present specification, to make the necessary changes in the reference device. Moreover, rearranging the specific claimed first and second elements as proposed in the Office Action would modify the operation of the device. In other words the

rearrangement would negative the second protective element in series with the first protective element and located on a line side of the first protective element, including a fuse, to provide short-circuit protection of the first protective element and the motor.

It is also admitted in the Office Action that Kruzic fails to disclose or suggest an electronic switching element as claimed. In an effort to overcome the admitted deficiencies, it is alleged that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Kruzic by adding the semiconductor controlled rectifiers (SCR) 17, 18 of Riseberg.

Even assuming *arguendo* that such a modification would have been obvious to one of ordinary skill in the art at the time of the invention, the combination of references fails to render the rejected claims obvious because Riseberg fails to overcome the deficiencies of Kruzic. For example, Riseberg fails to disclose or suggest second protective element in series with the first protective element and located on a line side of the first protective element, including a fuse, to provide short-circuit protection of the first protective element and the motor.

As the combination of references fails to render the claims obvious, withdrawal of the rejection is respectfully requested.

Claims 7, 8, 17 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kruzic in view Riseberg and further in view of “current design practice.” The rejection is respectfully traversed.

In rejecting claims 8 and 18, the Office Action fails to provide any support for the rejection. Rather, the Office Action only alludes to a basis for rejecting the subject matter of claims 7 and 17. Thus, a *prima facie* case of obviousness has not been established for claims 8 and 18. As such, the next Office Action cannot be made final.

Moreover, as neither Kruzic nor Riseberg disclose or suggest a switching device, wherein the protective device and the switching device include widths of the same dimensions. The criticality of this claimed structural distinction is described at paragraphs [0009] and [0019] of the specification. As claims 8 and 18 are not rendered obvious by the combination of Kruzic, Riseberg and “current design practice” withdrawal of the rejection is respectfully requested.

Claims 5, 10, 15 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kruzic in view of Riseberg and further in view of US Patent 6,853,289 to Scoggin. The rejection is respectfully traversed.

Claims 5, 10, 15 and 20 are allowable for their dependency on their respective base claims, as well as for the additional features recited therein. Therefore, withdrawal of the rejection is respectfully requested.

Claims 3, 4, 13 and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kruzic in view of Riseberg and further in view of US Patent 2,324,852 to Frank. The rejection is respectfully traversed.

Claims 3, 4, 13 and 14 are allowable for their dependency on their respective base claims, as well as for the additional features recited therein. Therefore, withdrawal of the rejection is respectfully requested.

Claims 9 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kruzic in view of Riseberg and Frank. The rejection is respectfully traversed.

Claims 9 and 19 are allowable for their dependency on their respective base claims, as well as for the additional features recited therein. Therefore, withdrawal of the rejection is respectfully requested.

Claims 8 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kruzic in view of Riseberg and further in view of JP 2001-126607 to Okamoto. The rejection is respectfully traversed.

Claims 8 and 18 are allowable for their dependency on their respective base claims, as well as for the additional features recited therein. Further, the additional unit 4 is only described as a unit that will output a prealarm [0013]. Thus, Okamoto fails to disclose or suggest a protective device and a switching device having widths of the same dimensions. Therefore, withdrawal of the rejection is respectfully requested.

New Claim

New claim 21 is not anticipated or rendered obvious by any of the applied references whether considered alone or in combination. Specifically, the combination of references fails to disclose or suggest that the protective device is configured to be directly plugged onto the switching device.

CONCLUSION

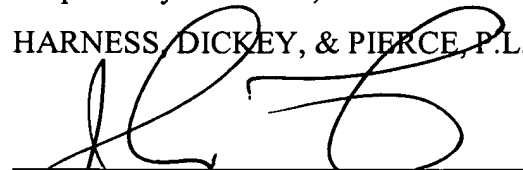
In view of the above remarks and amendments, Applicants respectfully submit that each of the rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Fitzpatrick at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,
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By


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